UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,896	09/28/2001	Travis J. Parry	10012806-1	4357

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER
HANG, VU B

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	09/966,896	PARRY, TRAVIS J.
	Examiner	**Art Unit**	
	Vu B. Hang	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 September 2001</u>.

2a)☒ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-24</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 September 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date <u>11/15/2005</u>.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canon

Kabushiki Kaisha Tokyo (JP) (European Patent 00,304,448.4) in view of Ohta (US Patent

6,980,319 B1).

Regarding **Claim 1**, Canon discloses a method of sending a print job to a printer

(see [0001], Line 7-14), comprising: attaching at least one document to an e-mail

message (see [0003], Line 29-32), sending the e-mail message over a network to e-mail

enabled printer (see [0001], Line 7-14), and extracting at least one document from the

e-mail message by the e-mail enabled printer (see [0016], Line 28-37). Cannon fails to

expressly disclose that the e-mail enabled printer includes e-mail client software. Ohta,

however, discloses the storage of client e-mail software in a remote printer for receiving

print data (see Fig.10 (48), Col.7, Line 57-67 and Col.8, Line1-13).

Cannon and Ohta are combinable because they are reform the same field of

endeavor, namely network printing systems. At the time of the invention, it would have

been obvious for one skilled in the art to include e-mail client software to the e-mail

enabled printer. The motivation would be to allow for the printer receive print jobs via e-

mails in a network environment.

Regarding **Claims 2 and 5**, Canon discloses storing print data in a print job

object to be transferred to an adapter connected to a printer (see [0069, Line 46-50).

Cannon also discloses that a printer in the network can store information coming from

the network server (see [0050], Line 27-31).

It is known in the art that printing devices contain high capacity storage area

known as job retention. At the time of the invention, it would have been obvious for one

skilled in the art to have attached documents be stored in the printer's job retention. The

motivation for doing so would be to enable a workstation user to print the same

documents at later time without repeating the e-mail transfer and retrieve process.

Regarding **Claims 3** and **4**, as mention in the 103(a) rejection of Claim 2 above,

Canon discloses storing print data in a print job object to be transferred to an adapter

connected to a printer (see [0069, Line 46-50) and that a printer in the network can

store information coming from the network server (see [0050], Line 27-31).

As mention the 103(a) rejection of Claim 2 above, it is known in the art that a

printer usually contains a job retention area. At the time of the invention it would have

been obvious for one skilled in the art to have an e-mail enabled printer to specify

instructions for storing and reading data to its job retention area. It is obvious that in

order to store data in the printer, the printer must specify its own instructions for storing

and reading the incoming data.

Regarding **Claim 6**, Canon discloses instructions for performing document prints

(see [0019]).

At the time of the invention, it would have been obvious for one skilled in the art to have the method of Claim 1 specify instructions for printing the attached document. Such instructions are necessary when performing print processes for any network printing system.

Regarding **Claim 7**, Canon discloses that the network print server providing a means for specifying printing attributes (see [0107] and [0108]).

At the time of the invention, it would have been obvious for skilled in the art to have the method of Claim 1 to specify printing attributes when specifying printing instructions. Specifying the print attributes is part of the instructions for printing data (i.e. part of a print job).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canon Kabushiki Kaisha Tokyo (JP) (European Patent 00,304,448.4) in view of Ohta (US Patent 6,980,319 B1), and in further view of Fabbio et al. (US Patent 5,870,089).

Regarding **Claim 8**, Canon discloses specifying instructions for documents prints as mentioned in Claim 6 but fails to disclose expressly scheduling the print instructions. Fabbio, however, discloses a means to schedule the transferring of data packages from a storage queue to destination devices (i.e. printer, fax) in a network (see Fig. 5 (118) and Col.8, Line 10-37).

Canon, Ohta and Fabbio are combinable because they are from the same field of endeavor, namely network printing apparatus. At the time of the invention it would have been obvious for one skilled in the art to incorporate the use of a scheduling process to prioritize or schedule the print process. The motivation for doing so would be to have a

set process of determining the priority of the documents to be printed. Since many documents could be stored to the job retention of the printer, it would be useful to prioritize documents and have them print in specific orders.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canon Kabushiki Kaisha Tokyo (JP) (European Patent 00,304,448.4) in view of Ohta (US Patent 6,980,319 B1).

Regarding **Claim 9**, Canon further discloses a printer readable program that contains instructions for printing (see [0019]), as mentioned in the 103(a) rejection of Claim 6 above.

At the time of the invention it would have been obvious for one skilled in the art to provide instructions via e-mail that is printer readable since the instructions will be stored in the job retention of the printer. The printer, therefore, must interpret the instructions to perform the printing in a network environment. Otherwise, the printer can only print based on instructions manually inputted by a user.

Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canon Kabushiki Kaisha Tokyo (JP) (European Patent 00,304,448.4) in view of Ohta (US Patent 6,980,319 B1), and in further view of Harkins et al. (US Patent 5,689,642).

Regarding **Claim 10**, Canon discloses specifying instructions for documents prints as mentioned in Claim 6 but fails to disclose expressly a method to encode the printable readable language prior to sending the e-mail message over the network. Harkins, however, discloses encoding printer readable language prior to transmitting the data over the network (see Col. 11, Line 28-41).

Canon, Ohta and Harkins are combinable because they are from the same field

of endeavor, namely network printing apparatus. At the time of the invention, it would

have been obvious for one skilled in the art to in corporate a method to encode the

printer readable language to the method described in Claim 6 above. The motivation for

doing so would be to create a more productive printing process by eliminating the need

to convert from multiple sender formats to the desired printer format by the printer.

Regarding **Claim 11**, Canon further discloses encoding the printer readable

language in MIME encoding field (see [0052], Line 6-10).

At the time of the invention, it would have been obvious for one skilled in the art

to use the MIME encoding field to encode the printer readable language. It is necessary

for the receiving printer or the controlling software of the receiving printer to understand

what the data received from the e-mail message represents. It is necessary to use the

MIME encoding field since it tells what is in the e-mail message so that the contents can

be used in an appropriate way.

Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Canon Kabushiki Kaisha Tokyo (JP) (European Patent 00,304,448.4) in view of Ohta

(US Patent 6,980,319 B1).

Regarding **Claim 12**, Canon further discloses a document attached to an e-mail

message is in an application-specific format (see [0017], Line 40-48 and [0052], Line 1-

6).

Regarding **Claim 13**, Canon further discloses a conversion of a document in an

application-specific format into a print ready file (see [0021], Line 33-38).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canon

Kabushiki Kaisha Tokyo (JP) (European Patent 00,304,448.4) in view of Ohta (US

Patent 6,980,319 B1), and in further view of Harkins et al. (US Patent 5,689,642).

Regarding **Claim 14,** Canon discloses the method as described in Claim 1 above

but fails to expressly disclose that the attached document to the e-mail message is in

bit-mapped format. Harkins, however, discloses bit-mapped files are being sent to the

printer over the network (see Col.2, Line 34-44).

Canon, Ohta and Harkins are combinable because they are from the same field

of endeavor, namely network printing apparatus. At the time of the invention, it would

have been obvious for one skilled in the art to have the document attached to the e-mail

message in bit-mapped format for the method described in Claim 1 above. The

motivation for doing so would be to create a more productive printing process. Having

the documents be converted to this format prior to being received at the printer would

speed the process of printing. With many documents/data to be printed stored in the

queue, it would be time consuming to have the conversion process done for each

document at the printer.

Claims 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Canon Kabushiki Kaisha Tokyo (JP) (European Patent 00,304,448.4) in view of Ohta

(US Patent 6,980,319 B1).

Regarding **Claim 15,** Canon discloses a method for distributing a document for

printing (see [0001]), comprising: attaching at least one document to an e-mail message

(see [0003], Line 29-32), sending an e-mail message to an e-mail enabled print server

of a local network (see [0009]), extracting the document at the e-mail enabled print

server (see [0016]), and sending the document to the network printer of the local

network by the e-mail enabled server (see [0021, Line 33-35). Canon fails to expressly

disclose attaching at least one document to an e-mail message at a workstation. Ohta,

however, discloses sending a print job to a print server from a workstation via e-mail

(see Fig.18 (S1, S2), Col.15, Line 32-55).

Cannon and Ohta are combinable because they are from the same field of

endeavor, namely network printing systems. At the time of the invention, it would have

been obvious for one skilled in the art to use a workstation to send a document to be

printed as an attachment via e-mail. The motivation would be to send print job

information to a remote printer in a network environment. It is well known in the art that

e-mailing information to a server via e-mail is necessary in client/server applications,

which includes network printing.

Regarding **Claim 16**, Canon further discloses a method comprising converting a

document into a print ready file by the e-mail enabled print server prior to sending the

document to the network printer (see [0021]).

Regarding **Claim 17**, Canon discloses storing print data in a print job object to be

transferred to an adapter connected to a printer (see [0069, Line 46-50). Cannon also

discloses that a printer in the network can store information coming from the network

server (see [0050], Line 27-31).

It is known in the art that printing devices contain high capacity storage area

known as job retention. At the time of the invention, it would have been obvious for one

skilled in the art to have attached documents be stored in the printer's job retention. The

motivation for doing so would be to enable a workstation user to print the same

documents at later time without repeating the e-mail transfer and retrieve process.

Regarding **Claim 18,** Canon further discloses a method comprising printing at

least one document by the network printer (see [0009]).

Regarding **Claim 19**, Canon discloses a system for receiving and distributing a

remotely sent print job to a network printer (see Fig. 4), comprising: an e-mail enabled

server device for communication with a network (Fig.4, (3104)), the e-mail enabled

server configured for receiving an e-mail message having a document attached as a

print job (see Fig.4, (3103) and [0009]), the e-mail enabled print server configured for

extracting document from the e-mail message and for transmitting the document to at

least one network printer device (see [0020]), and a network printer device configured to

be communicatively coupled to the e-mail enabled print server device over the network

(see Fig. 6), the network printer device for storing and for printing print jobs transmitted

by the e-mail enabled print server device (see Fig.1 (108, 109) and [0053]). Cannon

fails to expressly disclose a print server configured for receiving an e-mail message

from a remote workstation. Ohta, however, discloses a print server configured to receive

print job data via e-mail from a workstation (see Fig.18 (S1, S2), Col.15, Line 32-55).

Cannon and Ohta are combinable because they are from the same field of

endeavor, namely network printing systems. At the time of the invention, it would have

been obvious for one skilled in the art to the system a print server configured to receive

print job data via e-mail from a client workstation. The motivation would be to send and

receive print job information to a remote printer in a network environment. It is well

known in the art that e-mailing information to a server via e-mail is necessary in

client/server applications, which includes network printing.

Regarding **Claim 20**, Canon further discloses a system wherein the e-mail

enabled print server device includes at least one microprocessor configured for

converting the document sent as print job into a print ready file (see Fig. 6 (2102)).

Regarding **Claim 21**, Canon discloses a computer system for processing print

jobs (see Fig.1), comprising: an e-mail enabled device for creating and sending e-mail

with attachments (see Fig.1 (101, 102)), an e-mail enabled printer for receiving,

extracting attachments from the e-mails, and printing the attachments (see Fig.1 (108,

109)), and a network for communicating emails between the e-mail enabled device and

the e-mail enabled printer (see Fig.1 (103, 106)). Cannon fails to expressly disclose that

the e-mail enabled printer incorporates e-mail client software for receiving e-mails.

Ohta, however, discloses the storage of client e-mail software in a remote printer for

receiving print data (see Fig.10 (48), Col.7, Line 57-67 and Col.8, Line1-13).

Cannon and Ohta are combinable because they are reform the same field of

endeavor, namely network printing systems. At the time of the invention, it would have

been obvious for one skilled in the art to include e-mail client software to the e-mail

enabled printer. The motivation would be to allow for the printer receive print jobs via e-

mails in a network environment.

Regarding **Claim 22**, Canon discloses storing print data in a print job object to be

transferred to an adapter connected to a printer (see [0069, Line 46-50). Cannon also

discloses that a printer in the network can store information coming from the network

server (see [0050], Line 27-31).

It is known in the art that printing devices contain high capacity storage area

known as job retention. At the time of the invention, it would have been obvious for one

skilled in the art to have attached documents be stored in the printer's job retention. The

motivation for doing so would be to enable a workstation user to print the same

documents at later time without repeating the e-mail transfer and retrieve process.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canon

Kabushiki Kaisha Tokyo (JP) (European Patent 00,304,448.4) in view of Ohta (US

Patent 6,980,319 B1), and in further view of Harkins et al. (US Patent 5,689,642).

Regarding **Claim 23**, Canon discloses specifying instructions for documents

prints as mentioned in Claim 6 but fails to disclose expressly a method to encode the

printable readable language prior to sending the e-mail message over the network.

Harkins, however, discloses encoding printer readable language prior to transmitting the

data over the network (see Col. 11, Line 28-41).

Canon, Ohta and Harkins are combinable because they are from the same field

of endeavor, namely network printing apparatus. At the time of the invention, it would

have been obvious for one skilled in the art to in corporate a method to encode the

printer readable language to the method described in Claim 6 above. The motivation for

doing so would be to create a more productive printing process by eliminating the need

to convert from multiple sender formats to the desired printer format by the printer.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canon

Kabushiki Kaisha Tokyo (JP) (European Patent 00,304,448.4) in view of Ohta (US

Patent 6,980,319 B1).

Regarding **Claim 24**, Canon discloses a computer system for processing print

jobs (Fig.1), comprising: an e-mail enabled device for creating and sending e-mail with

attachments (Fig.1 (101,102)), an e-mail enabled print server for receiving e-mails with

attachments, extracting attachments from e-mails and sending attachments for printing

(Fig.1 (105)), a network printer for receiving and printing attachments extracted from e-

mails by the print server (Fig.1 (102,109)), and a network facilitating communications

between the e-mail enabled device, the e-mail enabled server and the network printer

(Fig.1 (103,106)). Cannon fails to expressly disclose using a local or remote workstation

for creating and sending e-mails with attachments. Ohta, however, discloses sending a

print job to a print server from a workstation via e-mail (see Fig.18 (S1, S2), Col.15, Line

32-55).

Cannon and Ohta are combinable because they are from the same field of

endeavor, namely network printing systems. At the time of the invention, it would have

been obvious for one skilled in the art to use a workstation to send a document to be

printed as an attachment via e-mail. The motivation would be to send print job

information to a remote printer in a network environment. It is well known in the art that

e-mailing information to a server via e-mail is necessary in client/server applications,

which includes network printing.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

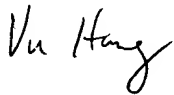than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Vu B. Hang whose telephone number is (571) 272-0582.

The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone

number for the organization where this application or proceeding is assigned is 703-

872-9306.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Vu Hang
Assistant Examiner

JOSEPH R. POKRZYWA
PRIMARY EXAMINER
ART UNIT 2622